



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Andreas Stahl, David J. Hirsch, Harvey F. Lodish, Ruth E. Gimeno and Louis Tartaglia

Application No.: 09/405,504

Group Art Unit: 1647

Filed: September 23, 1999

Examiner: S. Wegert

Title: Fatty Acid Transport Proteins

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REPLY TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Responsive to the Restriction Requirement dated October 1, 2001, Group (e) drawn to the nucleic acid with SEQ ID NO: 24 is elected for prosecution. Applicants reserve the right to file a continuing application or take such other appropriate action as deemed necessary to protect the non-elected inventions. Applicants do not hereby abandon or waive any rights in the non-elected inventions.

The requirement is being traversed with a request for modification for the reasons set forth in detail below.

REMARKS

This additional restriction requirement is directed to the claims of Group III as elected in Applicants' response filed June 26, 2001, and requires that Applicants elect a single nucleic acid

from the specified Groups (a) - (k). Applicants wish to point out that not all the sequences of Groups (a) - (k) are nucleic acids. While it is correct that the claims of Group III are directed to methods utilizing nucleic acids, in certain of the claims the nucleic acid sequence is specified, while in other of the claims the nucleic acid is specified as encoding a particular amino acid sequence. Therefore, Groups (e), (f), (g) and (h) are nucleic acid sequences, and Groups (a), (b), (c), (d), (i), (j) and (k) are amino acid sequences. In addition, it should be noted that Groups (b) and (i) contain the same sequence, while there is an overlap of sequences between Groups (a) and (k).

Applicants have elected Group (e), the nucleic acid sequence of SEQ ID NO: 24, with specific traverse. Applicants respectfully request that Groups (b), (e) and (f) be rejoined and examined together in this application. The nucleic acid sequence of Group (e) and that of Group (f) contain a great deal of homology because both encode the FATP1 protein represented by the amino acid of Group (b). SEQ ID NO: 24 contains 3704 nucleotides and SEQ ID NO: 46 contains 3694 nucleotides, a difference of only 10 nucleotides. Both sequences are fully identical throughout the entire coding region and both encode the same protein, that represented by the amino acid sequence of SEQ ID NO: 25.

The elected group contains a number of generic claims, claims directed to methods utilizing FATP proteins and claims directed to particular types of FATP proteins, *e.g.*, FATP1 proteins. A full examination of even the claims of the invention directed only to methods utilizing FATP1 nucleic acids cannot be performed without at a minimum evaluating the specified FATP1 nucleic acids (SEQ ID NO: 24; SEQ ID NO: 46) which encode the specified FATP1 amino acid sequence (SEQ ID NO: 25). Therefore, absent modification, the present restriction requirement results in Applicants not receiving an examination of their claimed invention.

Furthermore, it is well settled that restriction is improper unless search and examination represents an unreasonable burden:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. MPEP 803.

The rejoining of the three sequences cannot present an unreasonable burden to the Examiner because all three sequences have been fully searched in application no. 09/232,197 filed on January 14, 1999 which is now United States Patent No. 6,300,096 issued on October 9, 2001.

Therefore, because a reasonable examination on the merits requires at least the examination of SEQ ID NOS: 24, 25 and 46 in this application, and because the rejoinder of Groups (b), (e) and (f) does not place a serious burden on the Examiner, reconsideration and modification of the restriction requirement is respectfully requested.

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned at (978) 341-0036.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By Linda M. Chinn
Linda M. Chinn
Registration No. 31,240
Telephone (978) 341-0036
Facsimile (978) 341-0136

Concord, Massachusetts 01742-0133

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